

From: Lackman, Eleanor <eml@msk.com>
To: 'Edward T. Saadi' <edward@saadilaw.com>
Cc: Kang, Constance <cck@msk.com>
Date: Fri, 02-Aug-2024 13:31:19 -0400
Subject: RE: [EXTERNAL] Pleading reverse confusion

I do have an issue with it because it requires us to incur time and effort on preparing another answer with the counterclaim, reviewing your presumably new response, and otherwise delaying the proceedings.

If you are willing to cover our legal fees for all of this, I can bring that proposal to my client. Otherwise we'll go ahead and note that your amendment appears not to really be an amendment but rather window dressing.



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From: Edward T. Saadi <edward@saadilaw.com>
Sent: Friday, August 2, 2024 1:25 PM
To: Lackman, Eleanor <eml@msk.com>
Cc: Kang, Constance <cck@msk.com>
Subject: RE: [EXTERNAL] Pleading reverse confusion

Since you've always understood it to include reverse confusion, then you should have no issue with explicitly including it in the FAC.

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From: Lackman, Eleanor <eml@msk.com>

Sent: Friday, August 2, 2024 1:14 PM

To: 'Edward T. Saadi' <edward@saadilaw.com>

Cc: Kang, Constance <cck@msk.com>

Subject: RE: [EXTERNAL] Pleading reverse confusion

In my view, beyond the issues we raised in our 12(c) motion, reverse confusion was already sufficiently pleaded given the comments akin to “we want millions of dollars, which is more than our entire company is worth.” What prompted the addition? Is there magic language you need to include per this decision or otherwise, or are you just adding this as window dressing in order to slow down the process? It seems that we can moot the amendment given our view that **we have always understood your Lanham Act claim to include reverse confusion.**



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From: Edward T. Saadi <edward@saadilaw.com>

Sent: Friday, August 2, 2024 1:09 PM

To: Lackman, Eleanor <eml@msk.com>

Cc: Kang, Constance <cck@msk.com>

Subject: RE: [EXTERNAL] Pleading reverse confusion

“reverse confusion is not a separate claim that must be specifically pleaded, but instead is a theory of likely confusion that may be alleged by itself or in addition to forward confusion... Thus, **when reverse confusion is compatible with the theory of infringement**

alleged in the complaint, a plaintiff need not specifically plead it."

In other words... if reverse confusion is not specifically pleaded, it has to be compatible with the overall theory of infringement, otherwise there's a risk it won't be recognized. It doesn't just magically arise in every infringement case. The FAC eliminates any doubt that it is being pleaded.

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From: Lackman, Eleanor <eml@msk.com>
Sent: Friday, August 2, 2024 12:39 PM
To: 'Edward T. Saadi' <edward@saadilaw.com>
Cc: Kang, Constance <cck@msk.com>
Subject: RE: [EXTERNAL] Pleading reverse confusion

Can you please point me to the specific language where the ruling says that certain allegations need to be pleaded? This case seems to say the opposite.



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From: Edward T. Saadi <edward@saadilaw.com>

Sent: Friday, August 2, 2024 12:35 PM

To: Lackman, Eleanor <eml@msk.com>

Cc: Kang, Constance <cck@msk.com>

Subject: RE: [EXTERNAL] Pleading reverse confusion

Yes, as I said below, the case says that reverse confusion does not need to be separately pleaded. However, certain allegations do need to be made if a reverse confusion theory is to be available to a plaintiff. As the case says, “the allegations will vary in individual cases” and the overall allegations of the complaint do need to be compatible with a reverse confusion theory. The FAC clarifies that reverse confusion is being alleged, and eliminates any possibility that it will be unavailable to plaintiff.

ETS

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From: Lackman, Eleanor <eml@msk.com>

Sent: Thursday, August 1, 2024 7:51 PM

To: 'Edward T. Saadi' <edward@saadilaw.com>

Cc: Kang, Constance <cck@msk.com>

Subject: RE: [EXTERNAL] Pleading reverse confusion

Thanks, Edward. This case says: “[R]everse confusion is not a separate claim that must be specifically pleaded” and “when reverse confusion is compatible with the theory of infringement alleged in the complaint, a plaintiff need not specifically plead it.” So why again do you contend that the allegation needed to be made when the court says it “need not” be made?



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From: Edward T. Saadi <edward@saadilaw.com>

Sent: Thursday, August 1, 2024 4:45 PM

To: Lackman, Eleanor <eml@msk.com>

Subject: [EXTERNAL] Pleading reverse confusion

Eleanor, the case we discussed is attached. Reverse confusion need not necessarily be pled as a separate cause of action, however, there are certain allegations that must be included in a complaint to allege a cause of action for reverse confusion.

ETS

Sent from ETS's iPad